

REMARKS

This is the second Restriction Requirement issued in connection the above-referenced application. Applicant in response to the previous Restriction Requirement stated that the claims in Groups II, III and IV are ultimately linked to the claims in Group I since claims 7, 23 and 26 depend from claim 1, claims 9, 24 and 25 depend from claim 8 and claims 12 and 13 depend from claim 11. Claims 1 and 8 could be considered to be generic claims. Thus if claims 1 and 8 are allowed, the claims in groups II, III and IV should be linked to claims 1 or 8. Again, in the event that the Restriction Requirement is maintained, Applicant notes that the process claims in Groups II-IV are subject to the right of rejoinder once there is indication of allowable subject matter of the claims of Group I.

Further, Applicant had in the response to the previous Restriction Requirement elected with traverse SEQ ID NO:6 which encodes human adipocyte enhancer binding protein 1 depicted in SEQ ID NO:3 with respect to claims 1, 23 and 24; human adipocyte enhancer binding protein 1 with respect to claims 6 and 7 and the intron region with respect to claim 8 and 26. Applicant maintains this position. The Examiner in the instant Restriction Requirement stated

.....The searches required for proper examination of all of the inventions claimed would pose a serious search burden on both the Examiner as well as the facilities of the PTO, since all of the searches required would not be coextensive with each other (e.g. of the different sequences claimed, of the different methods claimed), although some of the required searches may overlap in part.

Furthermore, the MPEP citation mentioned by Applicant provides a suggested (as opposed to required) number of sequences considered reasonable to search. The suggested guidelines were written at a time when the data bases contained far less data than now, and so a search of up to ten sequences was less burdensome in the past. For these reasons, the restriction requirement mailed 4-21-06 was proper.

Applicant, in response, notes that the MPEP citation was actually taken from the most recent version of the MPEP, which was published August 2005. Therefore, Applicant would assume that these guidelines would still be in effect. Applicant does understand that the 10 nucleotide sequence limit is merely a suggestion. However, it is stated in MPEP 803.04

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In some exceptional cases, the complex nature of the claimed material, for example a protein amino acid sequence reciting three dimensional folds, may necessitate that the reasonable number of sequences to be selected be less than ten.

Such an exceptional case would not exist with the instantly claimed subject matter.

Therefore, in view of the above arguments, Applicant respectfully requests reconsideration of the previous Restriction Requirement.

It has further been stated with respect to claim 8 in this Restriction Requirement:

Pursuant to 35 U.S.C. 121 and 37 C.F.R. 1.141, the different target introns listed in claim 8, and encompassed in claims 11, 14-16, are subject to restriction. As per M.P.E.P. 2434, "the Commissioner has partially waived the requirements of 37 C.F.R. 1.141 and will permit a reasonable number of such nucleotide or amino acid sequences to be claimed in a single application." Applicant is required to elect a single intron region sequence from claim 8 (see also e.g. Table 2, pages 72-73 of the specification). Those sequences which are patentably indistinct from the sequence selected by the Applicant will also be examined.

Claim 8 specifically claims different nucleic acid sequence targets (*i.e.* different introns). Each of these target sequences is considered to be structurally independent, because each of these sequences has a unique nucleotide sequence. Furthermore, a search of all the sequences or targets claimed presents an undue burden on the Patent and Trademark Office to search and examine all of the recited or encompassed sequences. In view of the foregoing, applicants are required to elect up to ONE (1) claimed target intronic sequence.

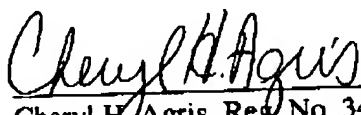
Applicant respectfully traverses this Restriction Requirement. Further, Applicant respectfully points out that specific intron sequences are **NOT** recited in claim 8. Claim 8 is only directed to an intron region. MPEP 2434 and related MPEP 803.04 are only directed to situations where specific nucleotide sequences are recited. Therefore, Applicant assumes especially, given that the Examiner states that "sequences patentably indistinct from the sequence selected by the Applicant will also be examined..", that a species election is requested in view of MPEP 809.02(a). In order to be responsive, Applicant elects with traverse intron 1 encompassing nucleotides 9015-10641 of SEQ ID NO:2. However, it is

Applicant's view that it would not be an undue burden to search all of the introns of SEQ ID NO:6.

In view of the above arguments, Applicant respectfully requests that the Restriction Requirement be withdrawn. An early action to that end is respectfully requested. The Examiner is invited to contact the undersigned at (914) 712-0093 if she wishes to discuss this response, the pending claims or application.

Respectfully submitted,

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